

REMARKS

Claim Rejections

Claim Rejection under 35 USC 102(b)- Jennings et al.

The Examiner rejected claims 1-4 and 6 as anticipated by Jennings et al. The Examiner characterized Jennings as disclosing a desktop (rigid laminate) comprising a top [sic] portion (reinforcing material) and an upper portion (laminate), with the upper portion having a pan-like sunken area with raised edges on the peripheral border. In making this rejection, the Examiner stated that process limitations are given little or no patentable weight. The Examiner then characterized the limitation self-bonded/self-bonding (collectively referred to as "self-bonding") as process limitations. The Applicants respectfully disagree with the Examiner's characterization of the self-bonding limitation as a process limitation.

The occurrence of a "process" word within a claim does not convert that claim into a product by process claim. Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 1570 (Fed. Cir. 1983). These "process" words may be interpreted as structural limitations when they are used in the adjective sense and define a physical characteristic of a given product. For example, the word "frozen" describes an objective characteristic of an object that can be determined through inspection, even though it can also describe the process of freezing. The interpretation of the two meanings is derived from the context of the application itself.

In the instant application, the Applicants have described a relationship between the laminate and the reinforcing material. The Applicants have used the term self-bonding in the adjective sense, not to imply information about the process that was used to manufacture the product. The Applicants describe several methods through which the reinforcing material can be applied to the laminate (page 5, lines 16-22). The relationship (self-bonding) between the laminate and the reinforcing material does not change with the method by which the reinforcing material is applied to the laminate. In addition, the self-bonding characteristic described and claimed in claims 1-4 and 6 can be determined on inspection (for example, by reverse engineering) of the product itself without the need to reference the exact process through which the product was made.

In In re Brown, 459 F.2d 531 (CCPA, 1972), relied upon by the Examiner the CCPA discussed the unique nature of product-by-process claims. Judge Baldwin stated that product-by-process claims are allowed under the patent statutes but discussed the difficulty of determining the patentability of such claims:

“It must be admitted, however, that the lack of physical description in a product-by-process claim makes determination of patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the *product* claimed and *not* of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.”

(In re Brown, 1041, emphasis in the original). With regard to the Applicants’ product, the concerns expressed above are not present. First, the claims at issue in this rejection are not product-by-process claims. Claims 1-4 and 6 do not recite process limitations as did the claims at issue in In re Brown. The limitation self-bonding is a structural limitation describing the relationship between the laminate and the reinforcing material. The Patent Office and the public at large will simply be required to determine if, among other structural limitations disclosed, their laminate is self-bonding to a reinforcing material to determine patentability or potential infringement, as the case may be.

Several additional cases have addressed this issue. In Vanguard Products Corp. v. Parker Hannifan Corp., 234 F.3d 1370 (Fed. Cir. 2000), the court discussed the interpretation of the phrase “integral therewith.” The patentee disclosed a claim that required a thick layer and a thin layer “integral therewith.” The court stated that the phrase integral therewith was indeed a structural limitation, not a process limitation, stating:

“The '854 specification shows that the term was used to describe the product, and not as a designation of a specific manufacturing process.”

Vanguard Products, Corp., 1372. The finding was made even though the patentee described in detail a co-extrusion process by which the thick and thin layer product could be made. The instant application takes this same approach in describing a relationship between the laminate and the reinforcing material and also describing several processes that could be used to economically produce the product.

In Hazani v. U.S. Int'l Trade Comm'n, 126 F.3d 1473 (Fed. Cir. 1997), the court addressed the issue of whether the phrase "chemically engraved" was a process limitation or a structural limitation. The court held that:

"We agree with the respondents, however, that those claims are best characterized as pure product claims, since the "chemically engraved" limitation, read in context, describes the product more by its structure than by the process used to obtain it. (citing In re Moore, 439 F.2d 1232 (1971) and In re Garnero, 412 F.2d 276 (1969))

Hazani, 1479. The same analysis is applicable to the phrase "self-bonding." When read in light of the Applicants' specification, the limitation describes the product more by its structure than the method used to produce the product.

Therefore, Applicants respectfully request that the Examiner reconsider her finding that the phrase "self-bonding" refers to a process limitation and read this term as a structural limitation of the product as claimed. In this light, claims 1-4 and 6 as applied to the Jennings et al. reference, Applicants note that the Jennings reference requires that the lower portion and upper portion be secured by threaded fasteners or adhesives (column 2, lines 44-46 and 55-58). The Jennings et al. reference does not teach or suggest the use of self-bonding upper or lower portions. In fact, the lower portion is illustrated as incorporating bosses 32 at each corner for receiving the threaded fasteners (column 2, lines 42-44 and fig. 4). Therefore, the Jennings et al. reference does not disclose or suggest the self-bonding limitations present in Applicants' claims 1-4 and 6.

Furthermore, Applicants note that the desk top of Jennings et al. specifically discloses and requires a "bumper" of material extending from the lower portion beyond the periphery of the upper portion to protect the desk top from damage in the event the desk is tipped over (column 2, lines 59-65 and figs. 3 and 4). The Applicants' rigid laminated material does not disclose the "bumper" of material as disclosed in the

specification and in FIGS. 2-4 but instead illustrate the reinforcing material being contained within the bounds of the laminate. Applicants have amended claims 1 and 4 to require the reinforcing material be contained within the area defined by the edges of the laminate.

Claim Rejection under 35 USC 102(b)- Steif et al.

The Examiner rejected claims 1-2 and 4-7 as anticipated by Steif et al. The Examiner characterized Steif et al. as disclosing a housing lining (rigid laminate) comprising a supporting frame (laminate) and a sound absorbent layer (reinforcing material). Applicants note that the supporting frame actually comprises an edge of the sound absorbent layer that has been compressed and glued together, in addition to an X-shaped supporting frame (which are collectively defined as the supporting structure). The Examiner noted that the supporting frame had a pan-like sunken portion with openings.

Applicants request that the Examiner note their arguments above regarding the "self-bonding" limitation and incorporate those arguments in this discussion. Applicants again note that the supporting frame is composed of fibers that are compressed and glued together and that the sound absorbent layer is actually a portion of the same material that has not been compressed. In addition, the sound absorbent layer is not bonded at all to the X-shaped supporting frame. Therefore, the sound absorbent layer is not self-bonding to the supporting frame, but is actually an integral piece of the frame or is not connected to the supporting frame at all.

Applicants note that claims 1, 4 and 6 have been amended to require that the reinforcing material be contained within the area defined by the edges of the laminate. As can be seen in FIG. 2, the sound absorbent material extends above the supporting frame. This is implicit in the design of the sound absorbent layer, since the sound absorbent material is composed of fibers that have not been compressed or that have been compressed only to a slight degree (column 3, lines 45-51), while the supporting frame (of which the sound absorbent layer is integral with, as noted above) is composed of fibers that have been compressed and glued together to form a pore free structure (column 3, lines 16-19). This difference in thickness is required so that the housing lining can absorb sound of various frequencies (column 3, lines 52-55).

Finally, Applicants note that claim 7 and amended claim 5 require that the at least one interior opening within the rigid laminated material extend completely through the rigid laminated material (i.e., the laminate and the reinforcing material). The function of the at least one opening in Applicants' rigid laminated material is to receive an object such as, but not limited to, a sink that is placed completely through the opening in the rigid laminated material. Steif et al. does not disclose or suggest a rigid laminated material that has an opening that extends completely through his device. The housing lining of Steif et al. discloses an opening 9 that extends through a portion of the supporting frame but not the sound absorbing layer. As discussed below, the function of the sound absorbing layer would be compromised if an opening extended through this layer. In addition, claim 7 requires that the laminate have edges raised from the reverse side that border the opening in the rigid laminated material. The raised edges for the opening are not taught or suggested by Steif et al (see FIG. 2). The function of the raised edges of the at least one opening in the Applicants' laminate is to create a seal between an object such as but not limited to a sink that is placed completely through the opening in the rigid laminated material. The function of the openings 9 in the housing lining of Steif et al. is to absorb (i.e., trap) sound via a Helmholtz resonator mechanism. Therefore, raised edges would not be required for such process.

For the Examiner's reference, the Applicants have attached copies of the primary cases cited above.

Applicant respectfully requests that the requested amendments be entered and that a timely Notice of Allowance be issued in this case.

Respectfully Submitted,

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10

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Enclosures: In re Brown

Vanguard Products Corp. v. Parker Hannifan Copr.

Hazani v. U.S. Int'l Trade Comm'n